

Appl. No. 09/814,402
Amdt. dated October 3, 2005
Reply to Office Action of July 7, 2005

REMARKS/ARGUMENTS

Applicant's attorney thanks the Examiner for her comments and for her thoughtful analysis of the references. Claims 1-7, 10-45 and 48-67 are presented for the Examiner's consideration. Claims 1, 17, 20, 24 and 28 have been amended to more clearly indicate the amount of liquid absorbed. Support for these amendments can be found on page 11, lines 10-18. Claim 24 has been amended to indicate a superabsorbent material content of greater than about 85%. Support for this amendment can be found in the Claims as originally filed and in the Examples. Independent claims 35, 37, 39, 53, 54 and 55 have been amended to include additional structural limitations. Support for these amendments can be found on page 11, lines 18-21; page 12, line 31 to page 13, line 2; in the Claims as originally filed; and in the Examples. Claims 8-9 and 46-47 are canceled. Claims 64, 65 and 66 are new. Support for claim 64 can be found on page 11, lines 1-21; page 12, line 31 to page 13, line 2; in the Claims as originally filed; and in the Examples. Support for claim 65 can be found on page 6, lines 18-20; page 7, lines 21-23; page 14, lines 15-16; and in the Claims as originally filed. Support for claims 66 and 67 can be found on page 10, lines 24-25; page 11, lines 18-21; page 12, line 19 to page 13, line 2; in the Claims as originally filed; and in the Examples.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

By way of the Office Action mailed July 1, 2005, the Examiner rejected claims 1-7, 10-14, 17-38 and 55-63 under 35 U.S.C. § 112, first paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The Examiner makes reference to *Ex parte Slob*, 157 USPQ 172, which states that the claim for a liquefiable substance was "too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition..." In *Ex parte Slob*, the applicants used characteristics to completely define the elements of the claims. In contrast to *Ex parte Slob*, Applicants' invention is relatively specific in that its broadest claims describe particular types of

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materials, as amended. Thus, it can be seen that the claims as amended do not fall under the scenario of *Ex parte Slob*, but in fact meet the requirements of 35 U.S.C. § 112. For at least these reasons, Applicants respectfully request that the rejection of claims 1-7, 10-14, 17-38 and 55-63 under 35 U.S.C. § 112 be withdrawn.

By way of the Office Action mailed July 1, 2005, the Examiner rejected claims 15-17, 19, 20, 22-24, 30-35, 37, 39, 40-45, 48-49 and 50-54 under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,516,569 to Veith et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The Examiner alleges that independent claims 15-17, 20, 24, 35, 37, and 53-54 are product-by-process claims in that the "limitation of the removal of liquid is directed to a process of making the article" and that if "the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." However, the Veith et al. reference provides evidence that the product of the present invention is not the same as the product of Veith et al. For example, Table 1 (see Example 2) of the present disclosure demonstrates that as the amount of superabsorbent material increases, the shake-out value generally decreases. In contrast, Table 1 of the Veith et al. reference demonstrates that as the amount of superabsorbent material increases, the shake-out value also generally increases. (See e.g., Samples 2, 3, 5, 6, 15 and 16). Since these trends are contrary to each other, the product of the present invention and the product of Veith et al. cannot be the same. For at least these reasons, the rejection of independent claims 15-17, 20, 24, 35, 37 and 53-54 is improper and Applicants respectfully request that the rejection be withdrawn.

The Examiner also alleges that independent claims 15-17, 20, 24, 35, 37 and 53-54 are product-by-process claims in that the "Shakeout Test is determined by performing a test set forth in the application" and that therefore "the claims also define the invention by process of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims." Applicants respectfully disagree with the Examiner. The "process" in a product-by-process claim is directed to a "method of production." (See e.g., MPEP 2113 and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). A test that is applied to a product after the product has been made is not a method of production. The Shakeout Test as used herein is a test that is applied to a web of the present invention after the web has been produced. For at least these reasons, this

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rejection of independent claims 15-17, 20, 24, 35, 37 and 53-54 is improper and Applicants respectfully request that the rejection be withdrawn.

The Examiner has also rejected independent claim 39 as allegedly being anticipated by Veith et al. In accordance with MPEP § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Claim 39 has been amended to address the Examiner's concerns. As such, Veith et al. do not set forth each and every element of amended claim 39. For example, Veith et al. do not set forth that the web is formed while the superabsorbent material contains at least about 0.5 grams of a liquid that it has absorbed per gram of superabsorbent material. For at least these reasons, the requirements of MPEP § 2131 are not met, and Applicants respectfully request that the rejection of independent claim 39 be withdrawn.

For at least the reasons given above, Applicants respectfully submit that independent claims 15-17, 20, 24, 35, 37 and 53-54 are allowable over Veith et al. Furthermore, since claims 19, 22-23, 30-34, 40-45, 48-49 and 50-52 recite additional claim features and depend from one of claims 15-17, 20, 24, 35, 37 and 53-54, these claims are also allowable over Veith et al. Accordingly, Applicants respectfully request withdrawal of this rejection.

By way of the Office Action mailed July 1, 2005, the Examiner rejected claims 1-7 and 10-14 under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 3,901,236 to Assarsson et al. in view of U.S. Patent Number 4,354,487 to Oczkowski et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

In accordance with MPEP § 2142, the Examiner has the burden of establishing a prima facie case of obviousness by meeting three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 4899 (Fed. Cir. 1991).

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Table 2 in the present application provides evidence that independent claim 1 is not obvious over U.S. Patent Number 3,901,236 to Assarsson et al. in view of U.S. Patent Number 4,354,487 to Oczkowski. In particular, Comparative Example 2 was produced in accordance with the teachings of Assarsson et al. (i.e., fibers are coated onto superabsorbent materials, the coated materials are dried, and then the dried coated materials are incorporated into a web.) Table 2 of the present invention demonstrates that as the amount of superabsorbent material increases in this comparative sample, the shakeout value also increases. In contrast, in the web of the present invention, Table 1 and Table 2 (see Example 2 and Example 3) demonstrate that as the amount of superabsorbent material increases, the shakeout value generally decreases, which is contrary to Comparative Example 2 which was made in accordance with Assarsson et al. Therefore, the second criteria of MPEP 2142 (i.e., there must be a reasonable expectation of success) has not been met, and nothing disclosed in Oczkowski et al. remedies this deficiency. Furthermore, since the in-situ polymerization technique of Oczkowski et al. is contrary to the superabsorbent material coating technique of Assarsson et al., there is no suggestion or motivation for one of skill in the art to modify the Assarsson et al. reference with Oczkowski et al. or to combine the reference teachings. Therefore, the first criteria of MPEP 2142 also has not been met. Thus, the Examiner has not met her burden of establishing a prima facie case of obviousness as required by MPEP 2142, and Applicants respectfully request that this rejection be withdrawn.

The Examiner also alleges that independent claim 1 is a product-by-process claim in that "the web formation is directed to a process of making the article," and in that the "Shakeout Test is determined by performing a test set forth in the application" and that therefore "the claims also define the invention by process of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims." With regard to web formation, Applicants have discussed and demonstrated above that the product of Assarsson et al. in view of Oczkowski et al. is not the same as the product of the present invention. (See e.g., Table 1 and Table 2 of the present disclosure.) With regard to the Shakeout Test, Applicants respectfully disagree with the Examiner that the Shakeout Test limitation makes claim 1 a product-by-process claim. The "process" in a product-by-process claim is directed to a "method of production." (See e.g., MPEP 2113 and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). A test that is applied to a product after the product has been made is not a method of production. The Shakeout Test as used herein is a test that is applied to a web of the present invention after the web has been

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produced. Thus, for at least these reasons, the rejection of independent claim 1 is improper and Applicants respectfully request that the rejection be withdrawn.

For at least the reasons given above, Applicants respectfully submit that independent claim 1 is allowable over Assarsson et al. in view of Oczkowski et al. Furthermore, since claims 2-7 and 10-14 recite additional claim features and depend from claim 1, these claims are also allowable over Assarsson et al. in view of Oczkowski et al. Accordingly, Applicants respectfully request that the rejection be withdrawn.

By way of the Office Action mailed July 1, 2005, the Examiner rejected claims 55-63 under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,516,569 to Veith et al. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

In accordance with MPEP § 2142, the Examiner has the burden of establishing a prima facie case of obviousness by meeting three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure. *In re Vaack*, 947 F.2d 4899 (Fed. Cir. 1991).

Veith et al. disclose an upper limit of superabsorbent material content of 85% by weight. (Veith et al. column 4, lines 8-10.) In contrast, independent claim 55 requires a superabsorbent material content of at least about 90% by weight. Therefore, the Veith et al. reference does not teach or suggest all of the claim limitations, as required by the third prong of MPEP § 2142.

In addition, as discussed above, the Veith et al. reference provides evidence that the product of the present invention is not the same as the product of Veith et al. For example, Table 1 of the present disclosure demonstrates that as the amount of superabsorbent material increases, the shake-out value generally decreases (see Example 2). In contrast, Table 1 of the Veith et al.

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reference demonstrates that as the amount of superabsorbent material increases, the shake-out value also generally increases. (See e.g., Samples 2, 3, 5, 6, 15 and 16). Since these trends are contrary to each other, there would be no suggestion, and one of ordinary skill in the art would not be motivated, to modify Veith et al. to increase the superabsorbent material content to at least about 90% by weight to achieve a shakeout value of less than 5% when subjected to the Shakeout Test as required in claim 55 of the present disclosure. Therefore, the first and second prongs of MPEP 2142 have not been met. Thus, the Examiner has not meet her burden of establishing a prima facie case of obviousness as required by MPEP 2142, and Applicants respectfully request that this rejection be withdrawn.

The Examiner also alleges that independent claim 55 is a product-by-process claim in that the "Shakeout Test is determined by performing a test set forth in the application" and that therefore "the claims also define the invention by process of manufacture, which require tests used to determine the test characteristics, and thus, the claims are product by process claims." With regard to web formation, Applicants have demonstrated above that product of Veith et al. is not the same as the product of the present invention. Additionally, with regard to the use of the Shakeout Test creating a product-by-process claim, Applicants respectfully disagree with the Examiner. The "process" in a product-by-process claim is directed to a "method of production." (See e.g., MPEP 2113 and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). A test that is applied to a product after the product has been made is not a method of production. The Shakeout Test as used herein is a test that is applied to a web of the present invention after the web has been produced. Thus, for at least these reasons, this rejection of independent claim 55 is improper and Applicants respectfully request that the rejection be withdrawn.

For at least the reasons given above, Applicants respectfully submit that independent claim 55 is allowable over Veith et al. Furthermore, since claims 56-63 recite additional claim features and depend from claim 55, these claims are also allowable over Veith et al. Accordingly, Applicants respectfully request that the rejection be withdrawn.

For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

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The undersigned may be reached at:

Respectfully submitted,

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